

STATUS OF THE CLAIMS

Claims 33-51 are pending in the Application.

Claims 33-51 have been rejected, herein.

Claims 1-38 have been cancelled, without prejudice, herein.

REMARKS

Cancelled Claims

Solely to expedite prosecution of the instant application, Applicant has cancelled Claims 33-38, without prejudice, and reserves the right to prosecute these claims, or the subject matter thereof, in this or a subsequent application.

Rejections under 35 U.S.C. § 103(a)

Claims 33-38 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Atkins (GB 2,299,568) in view of Mehta (U.S. Patent No. 6,073,377). Claims 39-41 and 48-50 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Atkins in view of Cillario (U.S. 4,472,895). Claims 39-42, 48, and 49 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Holden-Banks (GB 2,311,273) in view of Cillario. Claims 43-46 and 51 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Atkins in view of Cillario as applied to claims 39 and 50, and further in view of Kaufmann (U.S. Patent No. 5,264,265). Claims 43-46 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Holden-Banks in view of Cillario as applied to claim 39 above, and further in view of Kaufmann. Claim 47 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Atkins in view of Cillario and Kaufmann as applied to claim 46, and further in view of Mehta.

Claims 47, 50, and 51 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Holden-Banks in view of Cillario and Kaufmann as applied to claims 46 and 49, and further in view of Mehta. Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. §103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 706.02(j).

Regarding Claim 39, Applicant respectfully submits that the cited references, either separately or in combination, fail to teach or suggest every limitation of the present invention as claimed. Specifically, neither Atkins, Holden-Banks nor Cillario, alone or in combination, teach or suggest a method for making a device for labeling an object comprising providing a substantially planar member having first and second portions, wherein the second portion

overlaps at least a portion of the first portion around the periphery of the object, where the first portion of the member is oriented at an oblique angle relative to the second portion, and the second portion maintains a substantially similar width across the length of the second portion, as recited in Claim 39.

Applicant respectfully submits that the present Office Action misrepresents the Cillario reference by asserting that Cillario teaches “providing a label assembly that includes a first and second portion with the second portion overlaps at least a portion of the first portion around the periphery of the object” (present Office Action at page 4, point 3 and page 6, point 4). The Office Action further states that Cillario teaches a first portion (band or strip element 2) and a second portion (flap 6), oriented at an oblique angle to each other, and the second portion overlaps a portion of the first portion (present Office Action at page 4, point 3 and page 6, point 4).

Claim 39 clearly requires that the second portion overlaps at least a portion of the first portion *around the periphery of the object*, which Applicant respectfully submits is not taught by the Cillario. In contrast, Cillario teaches a first portion and second portion which are oblique relative to each other, but which clearly do **NOT** overlap around the periphery of the object. To the contrary, the oblique portions of the invention in the Cillario reference “reproduce the approximate disposition of a separate greetings card” (see Cillario at column 2, lines 17-18). Further, Figures 1-3 of Cillario clearly show that the first portion (band or strip element 2) and the second portion (flap 6), are perpendicular to each other, and merely overlap to form the appearance of a greeting card on one face of the object. Thus, the only portion of Cillario that might be deemed a second portion clearly does not overlap around the periphery of the object.

Accordingly, Applicant respectfully submits that the elements of Claim 39 are patentably distinguishable over each of Atkins, Holden-Banks and Cillario, at least because these references, either separately or in any combination, fail to teach or suggest a method for making a device for labeling an object comprising providing a substantially planar member having first and second portions, wherein the second portion overlaps at least a portion of the first portion *around the periphery of the object*, where the first portion of the member is oriented at an oblique angle relative to the second portion, and the second portion maintains a substantially similar width across the length of the second portion, as recited in Claim 39.

Therefore, for at least the reasons stated above, Applicant respectfully requests reconsideration and removal of the 35 U.S.C. § 103(a) rejections, because the cited references, either alone or in combination, do not teach or suggest each of the limitations of patentably distinguishable independent Claim 39. Applicant further submits that Claims 40-51 are similarly distinguishable over the prior art of record, at least by virtue of their ultimate dependency from patentably distinct base Claim 39.

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CONCLUSION

Wherefore, Applicant believes he has addressed all outstanding grounds raised by the Examiner and respectfully submits the present case is in condition for allowance, early notification of which is earnestly solicited. Should there be any questions or outstanding matters, the Examiner is cordially invited and requested to contact Applicant's undersigned attorney at his number listed below.

Respectfully submitted,

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